

*Appl. No. 10/019,650*

*Art Unit 3761*

*August 16, 2004*

*Second Reply to Office Action of August 11, 2004*

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

The amendment to the present specification is obviously editorial in nature and no new matter has been presented. The correct numbers are shown in the Figures of the specification.

The amendment to claim 1 is editorial in nature and for clarification purposes. Further, the Figures and pages 4-5 of the specification support this amendment. With this amendment, to claims 1-6 are pending in the above-identified application and stand ready for further action on the merits.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

***Claim Rejections Under 35 U.S.C. §§ 102 (e) and 103(a)***

Claims 1-2 and 6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yoshioka '023 (U.S. Patent No. 6,156,023).

*Appl. No. 10/019,650*

*Art Unit 3761*

*August 16, 2004*

*Second Reply to Office Action of August 11, 2004*

Further, claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshioka '023. Applicants respectfully traverse.

Previously in the reply of July 15, 2004, Applicants submitted arguments of patentability as to how the cited Yoshioka '023 reference fails to disclose or recognize all features as instantly claimed in the present invention. For example, Applicants submitted that Yoshioka '023 fails to disclose or teach disposing and fixing the elastic member to the raised portion 5B and the advantages obtained therefrom of the present invention (see the July 15<sup>th</sup> reply at page 4). Applicants also stated that it is a required element for the present invention that the elastic members are disposed and fixed to the approximately widthwise central portion of the raised portion 5B between the skin-contacting surface portion 5A and the base end 52 of the three-dimensional guard (see the July 15<sup>th</sup> reply at pages 2 and 3). Further, Applicants respectfully submitted that the barrier cuff 19 of Yoshioka '023 is not provided with an elastic member in the supporting wall section 16, which corresponds to the raised portion of the present invention.

*Appl. No. 10/019,650  
Art Unit 3761  
August 16, 2004  
Second Reply to Office Action of August 11, 2004*

In response, the Examiner issued an Advisory Action (dated August 11, 2004) stating that Applicants do not recite or claim an elastic member in a supporting wall section, and that the claim language only requires that the elastic members be disposed and fixed to a raised portion and that the elastic members in Yoshioka '023 are disposed in a raised portion (see Continuation of 2., page 2 of the Advisory Action). Applicants respectfully traverse as follows.

(A) *Elastic Members in Raised Portion of Present Invention*

First, Applicants respectfully submit that the elastic members were already recited to be in the raised portion, which corresponds to the "supporting wall section 16" of Yoshioka '023 (see Col. 2, lines 56-59). Previously, the claim language in claim 1 included "and said elastic members are respectively disposed and fixed to ... and to an approximately widthwise central portion of a raised portion between said skin-contacting surface portion and a base end of said three-dimensional guard". Thus, based on the claim language already presented, Applicants patentably distinguished over Yoshioka '023 because one having ordinary skill in the art would understand that the present invention is constructed differently

**Appl. No. 10/019,650**

**Art Unit 3761**

**August 16, 2004**

**Second Reply to Office Action of August 11, 2004**

than the Yoshioka '023 diaper and that the raised portion of the present invention corresponds to the "supporting wall section" of Yoshioka '023.

Further, Applicants herein submit Fig. 3 of Yoshioka '023 and Applicants' Figure 4, whereby Applicants have shown that the supporting wall section of Yoshioka '023 is constructed differently from the raised portion present invention. Yoshioka '023 in its patent specification describes section 16 as "obstructing an amount of body fluids tending to flow laterally and thereby to prevent sideways leakage" (see Col. 4, lines 18-25) (see submitted Fig. 3). In comparison, Figure 4 of Applicants' specification has a raised portion 5B that is shown to have elastic members 54d and 54e (see also the present specification at page 5, lines 16-20 and page 6, lines 8-16). But in contrast to the present invention, the elastic members 24A and 24B in Fig. 3 of Yoshioka '023 are in the overhand sections 17-18 (see Col. 3, lines 13-44). There is skin contact at the outer edge 27 of sealing surface section 20 in Yoshioka '023 (see Col. 4, lines 7+), versus skin-contacting surface portion 5A in the present invention. There are no elastic members in supporting wall section 16 or the barrier cuff 19 in Yoshioka '023.

**Appl. No. 10/019,650**

**Art Unit 3761**

**August 16, 2004**

**Second Reply to Office Action of August 11, 2004**

Given these descriptions and Figures, one of ordinary skill in the art would understand that not only does the raised portion of the present invention correspond to the supporting wall section of Yoshioka '023, but the skilled artisan would also understand that the present invention include elastic members whereby Yoshioka '023 does not. Thus, Applicants respectfully submit that these rejections have been overcome.

If it is the Examiner's position that the claim language of the present application only requires elastic members to be disposed at a raised portion and not at a supporting wall structure (see last sentence on page 2 of the Advisory Action), Applicants respectfully traverse this conclusion. The reference to a supporting wall structure is merely labeling of the Yoshioka '023 structure, wherein such structure corresponds to the raised portion of the present invention. Applicants do not need to recite a "supporting wall structure" since one of ordinary skill in the art would understand that there exists two parts of the Yoshioka '023 structure - - the overhanging areas 17 and 18 that contacts skin and the barrier cuff 19 having a liquid impervious nonwoven fabric or plastic sheet (see Col. 4, lines 44-49). Further, the skilled artisan would understand what parts of the Yoshioka '023 diaper

*Appl. No. 10/019,650  
Art Unit 3761  
August 16, 2004  
Second Reply to Office Action of August 11, 2004*

would properly correspond to the parts of the present invention. Applicants respectfully submit that this rejection has been overcome.

(B) *Elastic Portions of "Raised Portion" of Yoshioka '023*

In the Advisory Action of August 11, 2004, the Examiner states that Yoshioka '023 has elastic members (24A-24C) that are disposed in a raised portion as shown in Fig. 3. However, Applicants respectfully refer the Examiner to elements 16, 19, 17 and 18 of Yoshioka '023. The elastic members are only present in overhand sections 17-18 in Yoshioka '023.

Still, if the Examiner takes the position that all of the elements 16, 19, 17 and 18 in Yoshioka '023 constitute a "raised portion", Applicants submit that Yoshioka '023 still does not disclose the features of the present invention. Specifically, Applicants' claim 1 recites that the elastic members are within the skin-contacting surface portion and also at a (approximately widthwise) central portion of the raised portion. The raised portion is "between said skin-contacting surface portion and a base end of said three-dimensional guard" (see pending claim 1; see also 5B of Applicants' Figure 4). However, if all of the elements 16,

*Appl. No. 10/019,650*

*Art Unit 3761*

*August 16, 2004*

*Second Reply to Office Action of August 11, 2004*

19, 17 and 18 in Yoshioka '023 constitute a "raised portion", Yoshioka '023 only has elastic members at overhand sections 17 and 18, and there are no elastic members at the positions as claimed by Applicants (i.e., at a central portion of the asserted "raised portion" of Yoshioka '023). Yoshioka '023 limits its elastic members to surface zone 20 and not as a part of barrier cuff 19 (see Col. 3, lines 13+). Thus, Applicants respectfully maintain their position that Yoshioka '023 does not disclose all claimed features of the present invention and these rejections have been overcome.

Further, if all elastic members are within the "raised portion" of Yoshioka '023 represented by numbers 16, 19, 17 and 18 in Fig. 3 of this reference, then there would not exist a separate skin-contacting portion as instantly claimed. This is another reason as to why the Yoshioka '023 reference fails to disclose all features as instantly claimed.

Also, one of ordinary skill in the art would understand that the present invention is structurally and patentably distinct from the cited Yoshioka '023 reference. Yoshioka '023 describes that supporting wall section 16 cooperates with overhand section 17 so that a pocket 31 is formed that opens downward and inward of diaper

*Appl. No. 10/019,650*

*Art Unit 3761*

*August 16, 2004*

*Second Reply to Office Action of August 11, 2004*

1 (see Col. 4, lines 3-6 and Fig. 3). In the present invention the skin-contacting portion 5A is folded back along elastic member 54c, so that there is a free angle with respect to raised portion 5B that conforms to the movement of the user (see the present specification at page 4, lines 21-23). Thus, the skilled artisan would understand that supporting wall section 16 of Yoshioka '023 corresponds to the raised portion 5B of the present invention, wherein each portion/section can form an angle or pocket. With this understanding and disclosure, one of ordinary skill in the art would also understand that the elastic members of the present invention versus that of Yoshioka '023 reside in different locations. Again, Applicants respectfully refer the Examiner to Fig. 3 of Yoshioka and Figure 4 of the present invention (submitted herein), which shows that the elastic members of the present invention that reside in the raised portion do not exist in the Yoshioka '023 embodiment. Thus, Applicants respectfully submit that this rejection has been overcome.

(C) *The Claims Are Clearly Distinguishable from the Disclosure of Yoshioka '023*

*Appl. No. 10/019,650  
Art Unit 3761  
August 16, 2004  
Second Reply to Office Action of August 11, 2004*

In addition, Applicants respectfully refer the Examiner to claim 1 as presented. The present invention does require elastic members to be in the raised portion wherein the raised portion is clearly defined as a separate region from the skin-contacting portion, and the cited Yoshioka '023 reference fails to disclose all features as instantly claimed. Thus, Applicants herein incorporate all previous remarks as stated in the July 15, 2004 reply since such remarks instantly apply.

Based on the above remarks, because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Yoshioka '023 reference cannot be a basis for a rejection under § 102. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Yoshioka '023 is overcome. Reconsideration and withdrawal are respectfully requested.

Similarly, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) as been overcome since a *prima facie* case of obviousness requires disclosure of all claimed features. See *In*

**Appl. No. 10/019,650**

**Art Unit 3761**

**August 16, 2004**

**Second Reply to Office Action of August 11, 2004**

re Vaeck, 947 F.2d, 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); see also *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Here, Yoshioka '023 fails to disclose all features as instantly claimed as mentioned above. Thus, this rejection has been overcome.

**Conclusion**

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of two (2) months to August 15, 2004 in which to file a reply to the Office Action. The required fee of \$420.00 is enclosed herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

**Appl. No. 10/019,650  
Art Unit 3761  
August 16, 2004  
Second Reply to Office Action of August 11, 2004**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By John W. Bailey #32,881  
John W. Bailey, #32,881

JWB/*if*  
JWB/enm  
0445-0316P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachments: Figure 3 of U.S. Patent No. 6,156,023  
Figure 4 of Applicants' specification